

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-77 are pending. Claims 1-77 have been rejected.

Claims 1, 33, 34, and 61 have been amended. Claim 65 has been canceled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicant submits that the amendments do not add new matter.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-4, 6-10, 11-29, 31-38, 40-44, 45-77 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,267,303 to Johnson, et al. (“Johnson”).

Amended claim 1 includes: identifying at least one action set forth in the image; identifying at least one document, wherein the identifying the at least one action based on the second plurality of check boxes and the identifying the at least one document based on the first plurality of check boxes is performed using a single image; and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document.

Johnson discloses using one form to request automatic creation of another form with fields for requesting operations in relation to items. More specifically, Johnson discloses that when a fax server receives an image of the Starter form (**Figure 7**), the fax server creates a new form to request a particular operation, as specified in the Starter form (**Figure 8**, col. 18, lines 14-col. 19, line 34). In particular, Johnson discloses that the Send form is created if the “send” check box in the respective field 530 of the Starter form is marked (col. 19, lines 35-40).

Thus, Johnson merely discloses creating another form to request a particular operation, in contrast to identifying the at least one action based on the second plurality of check boxes and the identifying the at least one document based on the first plurality of check boxes from a single

image, and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document, as recited in amended claim 1.

Because Johnson fails to disclose all limitations of amended claim 1, applicant respectfully submits that amended claim 1 is not anticipated under 35 U.S.C. §102(b).

Because claims 4, 6-10, 11-29, 31-38, 40-44, and 45-77 contain discussed limitations, applicant respectfully submits that claims 4, 6-10, 11-29, 31-38, 40-44, and 45-77 are not anticipated by Johnson under 35 U.S.C. §102(b).

REJECTIONS UNDER 35 U.S.C. § 103

Claims 10 and 39 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson as applied to claim 1 above, and further in view of U.S. Patent No. 6,409,401 to Petteruti, et al. (“Petteruti”).

It is respectfully submitted that Johnson does not teach or suggest a combination with Petteruti, and Petteruti does not teach or suggest a combination with Johnson. Johnson teaches creating the forms to request operations in relation to items.

Petteruti, in contrast, discloses a portable printer with the RFID encoder, and similarly to Johnson, fails to disclose identifying the at least one action based on the second plurality of check boxes and the identifying the at least one document based on the first plurality of check boxes from a single image, and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document, as recited in amended claim 1.

Thus, neither Johnson, Petteruti, nor any combination thereof, discloses such limitations of amended claim 1.

Because claims 10 and 39 contain discussed limitations, applicant respectfully submits that claims 10 and 39 are not obvious under 35 U.S.C. § 103(a) over Johnson in view of Petteruti.

Claims 5 and 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Cooper.

It is respectfully submitted that Johnson does not teach or suggest a combination with Cooper, and Cooper does not teach or suggest a combination with Johnson. Johnson teaches creating the forms to request operations in relation to items.

Cooper, in contrast, discloses assigning an image domain label to the file, and similarly to Johnson, fails to disclose identifying the at least one action based on the second plurality of check boxes and the identifying the at least one document based on the first plurality of check boxes from a single image, and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document, as recited in amended claim 1.

Thus, neither Johnson, Cooper, nor any combination thereof, discloses such limitations of amended claim 1.

Because claims 5 and 30 contain discussed limitations, applicant respectfully submits that claims 5 and 30 are not obvious under 35 U.S.C. § 103(a) over Johnson in view of Cooper.

CONCLUSION

It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If there are any additional charges, please charge Deposit Account No. 02-2666 for any fee deficiency that may be due.

Respectfully submitted,

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